

## **REMARKS**

Reconsideration and withdrawal of the rejections of the claimed invention is respectfully requested in view of the amendments, remarks and enclosures herewith, which place the application in condition for allowance.

### **I. STATUS OF CLAIMS AND FORMAL MATTERS**

With the entry of this amendment, claims 8, 11, 12, 14-18, 20, 21 and 30-36 are now pending in this application. Claim 8 has been amended to include a narrower scope of herbicide (A) which is a subset of the herbicides present in claim 13 at the time of the previous Office Action. Claims 14, 16 and 17 have been amended accordingly. No new matter has been added by this amendment.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

### **II. THE 35 U.S.C. 112, 2<sup>nd</sup> PARAGRAPH REJECTION HAS BEEN OVERCOME**

Claims 13-32, 34 and 35 were rejected as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regards as the invention and have been overcome in light of the above amendments.

### **III. THE 35 U.S.C. 102(b) REJECTION HAS BEEN OVERCOME**

Claims 8, 11-17 and 31-36 were rejected as allegedly being anticipated by Rosch et al. (U.S. Patent 5,700,758 – “Rosch”). The applicants request reconsideration of this rejection for the following reasons.

In order to establish a holding of anticipation, MPEP 2131 illustrates the requirements necessary to establish anticipation, each and every element set forth in the claim must be found, either expressly or inherently described, in a single prior art reference<sup>1</sup> and that the identical invention must be shown in as complete detail as is contained in the applicants’ claim<sup>2</sup>. *See MPEP 2131.*

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<sup>1</sup> See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

<sup>2</sup> See *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The previous Office Action appeared indicate a misunderstanding about the method of use disclosed by Rosch as the method of use by Rösch is to provide a safening effect (a recognized term of art in the field of agrochemistry)<sup>3</sup> **NOT** to increase weed control as in the applicants' claimed invention.

There is no indication that Rösch recognized that the combination of a compound (B) herbicide with another herbicide would have resulted in increasing weed control, i.e. **causing** an action on the **weeds**; Rösch is trying to **prevent** an action, i.e. preventing unwanted phytotoxic effects of an herbicide on a **crop** when used in combination with a safener.

Not only was there no awareness for increasing weed control from within the Rösch reference, there was no direction as to which specific herbicide (in this case an aryloxyphenoxypropionate selected from the group consisting of clodinafop-propargyl, diclofop, diclofop-methyl, fenoxaprop-P-ethyl, fenoxaprop-P, fenoxaprop-ethyl, fenoxaprop and salts thereof) should have been selected to achieve the increase in weed control.

As every element of the applicants' claimed method has not been taught by Rösch nor have the elements been taught to show the identical invention in as complete detail contained in the applicants' claim, Rösch does not anticipate the applicants' claimed method of increasing weed control.

#### **IV. THE 35 U.S.C. 103(a) REJECTION HAS BEEN OVERCOME**

**1. Claims 18, 20-23, 25-28 and 30 were rejected as allegedly being obvious by Rosch et al.** (U.S. Patent 5,700,758 – "Rosch"). The applicants request reconsideration of this rejection for the following reasons (as claims 19, 24 and 29 have been cancelled, the rejection of these claims in view of Rosch, Sixl and Heinrich has been rendered moot)

As noted above, Rosch does not teach a method of increasing weed control, but is referring to a method of providing a safening effect for an herbicide. Nothing from within Rosch, Sixl or Heinrich suggests that the applicants' claimed combination would have resulted in a method of increasing weed control; merely reducing the phytotoxic effect of an herbicide against desired plants/crops.

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<sup>3</sup> safener - A chemical that when used in combination with a pesticide reduces its effects on non-target organisms. Only herbicide safeners have so far been produced, and these protect crops from injury by herbicides but do not prevent the herbicide from killing weeds. (<http://www.alanwood.net/pesticides/glossary.html>)

As further evidence of non-obviousness, the applicants provided evidence of secondary considerations, i.e. unexpected results. In Tables 2 and 3 of the specification, an herbicide (A) was combined with a compound (B) and in each case produced a synergistic effect for weed control against wheat, i.e. the use of compound (B) produced no weed control when used alone, but when used in combination with an herbicide (A), the weed control unexpectedly increased. Nothing from Rosch, Sixl or Heinrich would have predicted this unexpected result.

Therefore, Rosch does not render the applicants claimed invention to be obvious as all of the elements for the applicants' claimed method of use are not present in Rosch and further Rosch does not teach or suggest the unexpected results shown by the applicants.

**CONCLUSION**

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,  
FROMMER LAWRENCE & HAUG LLP

By: /Howard C. Lee/  
Marilyn M. Brogan      Howard C. Lee  
Reg. No. 31,223      Reg. No. 48,104  
Telephone:      (212) 588-0800  
Facsimile:      (212) 588-0500